

### **REMARKS**

The Official Action mailed June 17, 2005, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to October 17, 2005. Accordingly, the Applicants respectfully submit that this response is being timely filed.

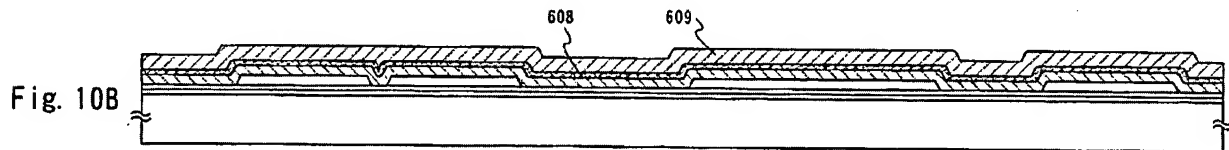
The Applicants note with appreciation the consideration of the Information Disclosure Statements filed on August 28, 2003, and December 3, 2004. A further Information Disclosure Statement is submitted herewith and consideration of this Information Disclosure Statement is respectfully requested.

Claims 1-73 were pending in the present application prior to the above amendment. Claims 1, 6, 9-11, 14-16, 19-21, 24-26, 29-31, 34 and 35 have been canceled, claims 3-5, 8, 13, 18, 23, 33 and 38-47 have been amended to better recite the features of the present invention, and new claims 74-80 have been added to recite additional protection to which the Applicants are entitled. The Applicants note with appreciation the allowance of claims 36-57 (pages 7-8, Paper No. 20050615). Claims 2, 7, 12, 17, 22, 27, 32 and 58-73 have been withdrawn from consideration (Office Action Summary, Id.). Accordingly, claims 3-5, 8, 13, 18, 23, 28, 33, 36-57 and 74-80 are currently elected, of which claims 3, 36, 37 and 74 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

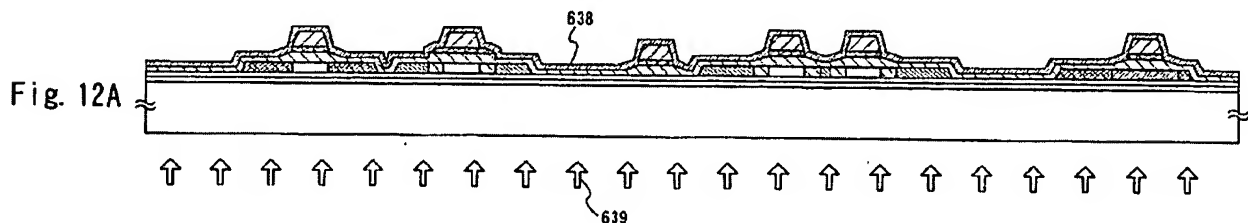
The Official Action rejects claims 1, 3-6, 8-10, 21, 23-26, 28-31 and 33-35 as anticipated by U.S. Patent Application Publication No. 2002/0061661 to Dairiki. The Applicants respectfully submit that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claim 3 has been amended to recite that a conductive layer extends beyond each periphery of first and second semiconductor layers at least when selective heating of the first and second semiconductor layers is performed. The Official Action relies on first and second conductive layers 608, 609 of Dairiki to allegedly teach the conductive layer of the claims of the present application (page 3, Paper No. 20050615). With respect to layers 608, 609, the Official Action appears to rely on the heat treatment step disclosed at paragraph [0107] and Figure 12 to allegedly teach the selective heating step of the claims of the present application (page 4, Id.). Although Dairiki may teach that conductive layers 608, 609 extend beyond a periphery of a semiconductor layer before heat treatment, for example, as shown in Figure 10B (reproduced below), the conductive layers 608, 609 do not extend beyond each periphery of first and second semiconductor layers when selective heating of the first and second semiconductor layers is performed.



In other words, when heating of the first and second semiconductor layers of Dairiki is performed (Figure 12A, reproduced below), the portions of the conductive layers 608, 609 that remain (i.e. electrodes 621 and 630-632) do not extend beyond each periphery of first and second semiconductor layers.



Therefore, the Applicants respectfully submit that Dairiki does not teach that a conductive layer extends beyond each periphery of first and second semiconductor

layers at least when selective heating of the first and second semiconductor layers is performed, either explicitly or inherently.

Since Dairiki does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

The Official Action rejects dependent claims 11, 13-16 and 18-20 as obvious based on the combination of Dairiki and U.S. Patent Application Publication No. 2002/0000551 to Yamazaki et al. The Applicants respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

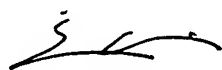
As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Dairiki. Yamazaki does not cure the deficiencies in Dairiki. The Official Action relies on Yamazaki to allegedly teach the features of dependent claims 11, 13-16 and 18-20. Specifically, the Official Action relies on Yamazaki to teach the composition of the substrate or the transmittance of the substrate (pages 6-7, Paper No. 20050615). However, Dairiki and Yamazaki, either alone or in combination, do not teach or suggest that a conductive layer extends beyond each periphery of first and second semiconductor layers at least when selective heating of the first and second semiconductor layers is performed. Since Dairiki and Yamazaki do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

New claims 74-80 have been added to recite additional protection to which the Applicants are entitled. For the reasons stated above and already of record, the Applicants respectfully submit that new claims 74-80 are in condition for allowance.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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